

REMARKS

The abstract of the specification has been amended herein as may be appreciated from the above. The amendment resolves the objection to the abstract issued in the Office Action dated April 28, 2010 (hereafter "Office Action"). The amendment should be entered as it resolves issues for appeal.

The claims have also been amended as may be appreciated from the above listing of claims. Claim 39 was amended to change the term "the communication device" to recite "the at least one communication device". No change in the scope of claim 39 is made by this amendment and there is no added burden placed on the Examiner by the amendment made to claim 39. Therefore, this amendment should also be entered.

The amendment does not require the payment of any fees. Nevertheless, authorization is provided herewith to pay any underpayment of fees or credit any overpayment of fees to Deposit Account No. 02-4800.

I. RESPONSE TO THE REJECTION OF THE PREVIOUSLY PRESENTED CLAIMS

The Examiner rejected pending claims 25-32 and 34-39 under 35 U.S.C. § 103 in view of U.S. Patent Nos. 5,805,677, to Ferry et al. and 7,058,356 to Slotznick. (Office Action at 3-8). Claim 33 and 40 were rejected as obvious in view of Ferry et al., Slotznick and U.S. Patent Nos. 5,948,080 to Baker. (Office Action, at 8).

A. Burden Of Proving Obviousness Under 35 U.S.C. § 103

"All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 (emphasis added). "When evaluating claims for

obviousness under 35 U.S.C. 103, **all the limitations of the claims must be considered and given weight.**" MPEP § 2143.03. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *Id.* "A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date." MPEP § 2141.01.

To establish a *prima facie* case of obviousness, an Examiner must show that an invention would have been obvious to a person of ordinary skill in the art at the time of the invention. MPEP § 2141. "Obviousness is a question of law based on underlying factual inquiries." *Id.* The factual inquiries enunciated by the Court include "ascertaining the differences between the claimed invention and the prior art" and "resolving the level of ordinary skill in the pertinent art." MPEP § 2141.

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, **there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**" MPEP § 2143.01 (citing *KSR*, 550 U.S. at 14, 82 U.S.P.Q.2d at 1396) (emphasis added).

For instance, an invention that permits the omission of necessary features and a retention of their function is an indicia of nonobviousness. *In re Edge*, 359 F.2d 896, 149 U.S.P.Q. 556

(CCPA 1966); MPEP 2144.04. A conclusory statement to the contrary is insufficient to rebut such an indicia of nonobviousness. *See* MPEP § 2143.01.

Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.01. Also, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." MPEP § 2143.01.

B. The Cited Art Does Not Teach Every Element Of The Pending Claims

Claim 25 requires a system to include at least one communication device. The at least one communication device is configured to automatically search for an active entertainment terminal when an administrative mode is selected such that the at least one communication device is connectable to the active entertainment terminal so a selection menu is displayable on the display of the active entertainment terminal after the active entertainment terminal is detected. Claims 26-39 depend directly or indirectly from claim 25 and therefore also contain these limitations.

1. None Of The Cited Art Teach Or Suggest A Communication Device Searching For An Active Entertainment Terminal

The Examiner admits that Ferry et al. do not teach or suggest any communication device that is configured to search for an active entertainment terminal when an administrative mode of that device is selected so that the device is connectable to an active entertainment terminal so that a selection menu is displayable on the display of the active terminal after that terminal is detected. (Office Action, at 4). However, the Examiner contends that Slotznick teaches or

suggests such features at Column 4, lines 30-34 & 55-63 and Column 10, lines 47-53. (Office Action, at 4).

To the contrary, Slotznick does not teach or suggest any communication device that is configured to search for an active entertainment terminal when an administrative mode of that device is selected so that the device is connectable to an active entertainment terminal so that a selection menu is displayable on the display of the active terminal after that terminal is detected. Slotznick requires a phone or TV phone to be directly connected to a TV. There is no searching for an active entertainment terminal conducted by the phones disclosed by Slotznick and Ferry et al. For instance, Slotznick teaches that a phone should have its base station attached to a TV or connected to a TV or that a phone should be directly wired to a TV. (Slotznick, at Col. 3, lines 10-49). As another example, Slotznick teaches that a set-top box actively transmits phone number information to a phone so that the phone may call that phone number. (*Id.* at Col. 3, lines 34-43).

Moreover, neither Slotznick nor Ferry et al. teach or suggest any display of any selection menu. For example, Column 4, lines 30-34 and lines 55-63 of Slotznick disclose a phone that is connectable to a TV so that a website is viewable on the TV or so that data and pictures downloaded on that TV phone are displayable on the TV. As another example, Column 10, lines 47-53 of Slotznick disclose a telephone that may dial a telephone number of a remote entity, such as a TV station that offers products for sales. (Column 10, lines 27-62). The dialing of a call provides no selection menu nor displays any selection menu on a TV or other entertainment terminal. Further, Ferry et al. do not teach or suggest any display of any selection menu on a TV or other entertainment terminal. Ferry et al. only disclose a display of telephone number or caller

information when an incoming call is detected. (Abstract, Col. 1, lines 15-28). There is no teaching or suggestion of any selection menu display on any entertainment terminal in the cited art.

Claims 25-39 are allowable for at least the above discussed reasons. The cited combination of art does not teach or suggest all the limitations of these claims.

2. Claim 28 Is Independently Patentable

Claim 28 depends from claim 25 and requires one or more communication devices to be configured to switch to the administration mode upon receiving an incoming call to set up a connection to the active entertainment terminal. The Examiner contends that Ferry et al. teaches or suggests the limitations of claim 28 at Column 1, lines 14-24, Column 5, lines 8-29, Column 10, lines 20-30. (Office Action, at 6).

To the contrary, there is no teaching or suggestion of any switching to any administrative mode upon receiving an incoming call in Ferry et al. As the Examiner admits, there is no mode disclosed by Ferry et al. that requires any searching for any entertainment terminal. Further, there is no switching to any such mode when an incoming call is received by a communication device taught by Ferry et al. In fact, Ferry et al. teach that an apparatus should include a detecting device for detecting an incoming call, a decoder device for decoding information relating to that call, and a transfer device for sending caller information to a TV or video device. (Abstract). There is no switching to any mode upon receiving an incoming call. The device disclosed by Ferry et al. is always in one mode and is always configured to display data on the video device. (Abstract, Col. 5, lines 10-29, Col. 10, lines 20-40).

None of the cited art teaches or suggests the limitations of claim 28. Claim 28 is independently patentable over the cited art.

3. Claim 39 Is Independently Patentable

Claim 39 depends from claim 25 and requires one or more communication devices to be configured to switch from a first mode to the administrative mode. The first mode and the administrative mode both require the one or more communication devices to be powered for operation such that the administrative mode and the first mode are not operational when the one or more communication devices are deactivated.

As noted above, none of the cited art teaches any administrative mode for automatically searching for an active entertainment terminal nor any display of a selection menu. Further, none of the cited art teaches or suggests any switching from a first mode to an administrative mode where both modes require power to be operational.

The Examiner contends that Ferry et al. discloses such modes and such switching at Column 1, lines 14-24, Column 5, lines 8-29 and Column 10, lines 20-40. (Office Action, at 8). The Examiner states that "when the call is received the 'administrative mode' takes over, 'switches', so that the user can manage the call." *Id.* To the contrary, no such switching or any "take over" of any call is taught by Ferry et al. Ferry et al. teaches a mechanism that displays incoming call information when an incoming call is detected. There is no teaching or suggestion of any taking over of any call or any managing of any call. The mechanism taught by Ferry et al. simply acts to alert a viewer of a TV of the fact that a call is being received. There is no taking over of any call, nor is there any switching into different modes. In fact, both Ferry et al. and Slotznick discloses devices that are only operational in one mode when they are powered.

None of the cited art teaches or suggests the limitations of claim 39. Claim 39 is independently patentable over the cited art.

4. None Of The Cited Art Teach Or Suggest The System Of Claim 40

Claim 40 requires a system to include at least one communication device configured to switch from a first mode to an administrative mode. Both the first mode and the administrative mode require the communication device to be powered for operation. The at least one communication device is configured to automatically search for an active entertainment terminal when the administrative mode is selected such that a selection menu is displayable on the display of the active entertainment terminal after the active entertainment terminal is detected. The display of the active entertainment terminal is also configured to receive input comprised of at least one of text and call administration data that is transmittable via touching the display. The display is configured to transmit the input received by the display to the at least one communication device to effect administration of a call.

As discussed above with reference to claims 25-39, the cited art does not disclose or suggest a communication device that searches for an active entertainment terminal or a communication device that switches from a first mode to an administrative mode. Moreover, the cited art does not teach or suggest the display of the active entertainment terminal to be configured to receive input comprised of at least one of text and call administration data as required by claim 40. The cited art also does not teach or suggest such a display being configured to transmit the input received by the display to the at least one communication device to effect administration of a call as required by claim 40. Further, the Examiner has failed to

meet her burden in providing any argument or rationale as to why the cited art would render claim 40 obvious.

C. EP Patent No. 1 402 723 B1 Shows The Pending Claims Are Allowable

The present application corresponds to granted European Patent No. EP 1 402 723 B1. For the Examiner's reference, a copy of this patent was previously provided to the Examiner with the Amendment dated October 2, 2009. The European Patent Office has found the invention disclosed in the present application to warrant patent protection. This is an indicia of the non-obvious nature of the pending claims and shows that the claims should be allowed.

III. CONCLUSION

Because the Amendment overcomes the Examiner's objection to the specification and does not change the scope of the claims this Amendment should be entered. For at least the above reasons, the claims are patentable over the cited references. Reconsideration and allowance are respectfully requested.

Respectfully submitted,

/Ralph G. Fischer/

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(412) 392-2121

Ralph G. Fischer
Registration No. 55,179
BUCHANAN INGERSOLL & ROONEY PC
One Oxford Centre
301 Grant Street
Pittsburgh, Pennsylvania 15219
Attorney for Applicant